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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,139	08/03/2000	Ryoichi Imanaka	MAT-3720US4	2101

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Ratner & Prestia
P O Box 980
Valley Forge, PA 19482

EXAMINER	
BROWN, RUEBEN M	
ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/632,139	IMANAKA, RYOICHI	
	Examiner	Art Unit	
	Reuben M. Brown	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14,17-19,21,22,37,40-42 and 44-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14,17-19,21,22,37,40-42 and 44-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. In light of the amendments of 7/9/2007, the 112, 1st paragraph rejection in the Office Action mailed 5/7/2007, has been withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 58 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Considering claim 58, the instant claim recites, 'a drive ID is checked, and if said drive ID is registered, recording of said information is said medium is permitted'. In reviewing the

specification, the reference to the instant subject matter is found in col. 5, lines 27-60. The relevant citation states, "User's drive operating state logging apparatus 12 collects the charge which is [an] information concerning to the subscriber's ID number and the user's drive operating state at every month from every subscriber and writes the charge information for every subscriber". Thus, even though the passage in the specification states that the subscribers' charges and drive operating state are collected, there was no discussion of how this drive operating status was being used. No direct support was found for the claimed condition, 'if said drive ID is registered, recording of said information is said medium is permitted'. This is particularly relevant, since the discussion in specification appears to be directed to functions that take place at the server apparatus, not the client apparatus, which is the environment of the claimed subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 14, 17-19, 21-22 & 37, 40-42, 45, 47, 49, 51, 53, 55, 57 & 58are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton, (U.S. Pat # 4,945,563) in view of Yoo, (U.S. Pat # 5,450,210).

Considering amended claim 14, the claimed computer information system comprising a provider for providing information to a recipient reads on the central office connected to the cable TV or satellite distribution system, see col. 3, lines 61-68. The additional claimed feature of the 'provider charging a different amount to the recipient depending upon whether the information is recorded' reads on the disclosure of Horton that a subscriber may preview a movie free-of-charge, may be charged a certain amount for viewing the movie and a different amount is charged when the movie is ordered for recording, col. 2, lines 25-67; col. 3, lines 40-55 & col. 4, lines 21-34.

Horton does not teach the amended claimed feature that the recording of information in the medium, 'is permitted if a value of an identifier read from the medium is a registered ID value, recording of the information in the medium is not permitted if any registered ID value is not readable from the medium'. Nevertheless, Yoo teaches a subscriber video library system that reads out and detects the ID code of tape inserted into a VCR before recording, in order to determine whether a new or old tape has been inserted, col. 4, lines 62-67 thru col. 5, lines 1-47..

It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton with the technique of only recording information on a particular

recording medium after verifying that a registered recording medium being identified, at least for purpose of ensuring that the tape is properly indexed according the method being used by the recording system, e.g., the video library system, VLS, as disclosed by Yoo, col. 2, lines 21-62; col. 2, line 45-67; col. 4, lines 30-67.

As for the claimed computer information system, Yoo discloses that the user system includes a microcomputer 90, (col. 3, lines 35-67; Fig. 1).

Considering claim 17, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected.

Considering claim 18, the claimed elements of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected. As for the different feature of receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

Considering claim 19, the claimed elements of a computer information system that corresponds with subject matter mentioned above in the rejection of claim 14, are likewise rejected. As for the different feature of a recipient for receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

Considering claim 21, the claimed signal transmitted from a recipient of information to a provider of information, such that the signal indicates whether the information is recorded in a medium, is met by the disclosure in Horton that the decoder 28 could provide billing information to the store and hold circuit 46, which is then transmitted to the proper billing authority, see col. 3, lines 35-60. The instant billing information shows which viewing mode was selected by the subscriber, and thus what charges are being billed.

Considering claim 22, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 21, and are likewise rejected.

Considering claim 37, the claimed elements of an information receiver, correspond substantially with the subject matter mentioned above in the rejection of claims 14 & 19, and are likewise rejected.

Considering claim 40, the claimed 'informing designating unit designate the information', is broad enough to the read on the decoder 28, that decodes the coded information and provides an indication to the user of the various modes of the particular decoded program, see Horton, col. 3, lines 35-42.

Considering claim 42, the information processed and viewed in Horton and Yoo is audio/video information.

Considering claims 45, 47, 49, 51, 53, 55, & 57, 'wherein the registered ID value is provided by the provider', in Horton that the taping mode may be selected by the operator 32, but the authorization code is embedded in the TV signal, col. 3, lines 32-67; col. 4, lines 1-45. Horton also teaches that alternatively, the pre-authorization code may be transmitted the receiver, which also indicates the reception/taping mode.

Considering claim 58, the claimed subject matter is interpreted as best understood, in view of the above 112, 1st paragraph rejection. The claimed subject matter is broad enough to read on the tape index code, as disclosed by Yoo, col. 3, lines 1-6; col. 3, lines 45-67.

4. Claims 44, 46, 48, 50, 52, 54 & 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton & Yoo, and further in view of Yarbrough, (U.S. Pat # 4,598,288).

Considering claims 44, 46, 48, 50, 52, 54 & 56, Horton & Yoo only discuss using a video tape within a VCR as a recording medium. However Yarbrough, which is in the same field of endeavor, teaches using recording medium of a video tape, as well as other recording apparatus, such as video disc or floppy disc, col. 7, lines 55-68, which reads on the claimed 'non-sequential accessible medium'. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton with the feature of a video disc or floppy disc for the

purpose of taking advantage of the known benefits of digital technology, as taught by Yarbrough, col. 7, lines 58-67.

5. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horton & Yoo as applied to claim 37 above, and further in view of Lindman, (U.S. Pat # 4,882,752).

Considering claim 41, even though both Horton & Yoo discuss the use of identifiers, the references do not discuss the additionally claimed feature of, 'an informing unit to inform that the identifier is wrong, if the identifier is not registered'. Nevertheless, Lindman (col. 9, lines 10-47; col. 10, lines 62-68 thru col. 11, lines 1-15 & Fig. 5) provides a teaching of informing a user of terminal 12a or 12b, when the personal ID code entered is not registered for authorization to use the system. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Horton & Yoo with the feature of informing a user when their personal ID is not authorized to access the system, at least for the desirable purpose of warning the operator that further communication is not authorized, as taught by Lindman, col. 9, lines 40-47.

5. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horton & Yoo, and further in view of Tsai, (U.S. Pat # 5,903,407).

Considering claim 59, Horton and Yoo do not discuss any feature regarding automated deletion of programs from the recording medium. Nevertheless Tsai, which is in the same field of endeavor teaches that a user may set an "auto-overwrite", so that for instance movies older than a certain data will be overwritten. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Horton & Yoo, with the feature of automatically removing programs older than a certain date, as taught by Tsai, at least for the desirable benefit of allowing incoming programs to be recorded, especially when there presently is not enough storage space, by removing (overwriting) programs that the user would more likely not want to maintain, based on their age in the storage medium.

It is noted out that Tsai specifically discuses the automated removal of old programs feature with respect to the overwrite technique, but does not explicitly discuss the automated removal of old programs feature with respect to the erasing technique. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate the combination of Horton &Tsai, in a manner such that the old programs would be optionally erased, at least for the purpose of being able to demonstrate storage space that has been created, which can be used to record new programs.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Ostrover Teaches not permitting playback of video content from a disc, unless the proper authorization code is reads from the instant disc.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:
(571) 273-8300, (for formal communications intended for entry)
Or:
(571) 273-7290 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown

REUBEN M. BROWN
PATENT EXAMINER